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In re Patent No. 7,488,735
Issued: February 10, 2009
Application No. 10/518,714
Filed: August 1, 2005
Dkt. No.: 09605.0045

OFFICE OF PETITIONS

: PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-POST GRANT," filed March 24, 2009. This matter is being properly treated under 37 CFR 1.705(d). Patentees request correction of the patent term adjustment from 387 days to either 584 days (Application for PTA p.1) or 580 days (Application for PTA p.2.). Patentees request this correction on the sole basis that the Office took in excess of three years to issue the above-referenced patent.

The application for patent term adjustment (PTA) under 37 CFR 1.705(d) is **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 7,488,735 on February 10, 2009. The patent issued with a patent term adjustment of 387 days. The instant application of patent term adjustment is timely filed pursuant to 37 CFR 1.705(d). Patentees argue that in view of Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), the patent is entitled to an adjustment of 580 days (416 days pursuant to 35 USC 154(b)(1)(A) *plus* 193 days pursuant to 35 USC 154(b)(1)(B) *less* 29 days applicant delay).

Patentees also state that "[t]he application was allowed on October 2, 2008, and the issue fee was paid on January 5, 2009. The patent issued on February 10, 2009, creating a PTO delay of four days."

The request for an additional adjustment of four days in connection with the issuance of the patent is **DISMISSED**. The issue fee was paid January 5, 2009. The patent issued February 10, 2009, within four months of the date of receipt of the issue fee. Therefore, no additional adjustment is warranted under 37 CFR 1.702(a)(4).

Under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time equal to the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

The Office asserts that as of the issuance of the patent on February 10, 2009, the application was pending three years and 405 days after national stage commenced under 35 U.S.C. 371(b) or (f) in an international application (January 3, 2008 to February 10, 2009). The Office agrees that certain action was not taken within the specified time frame, and thus, the adjustment of 416 days pursuant to 37 CFR 1.702(a)(1) is correct. At issue is whether patentees should accrue 405 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 416 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 405 days of delay in issuance of the patent under 37 CFR 1.702(b) overlaps with the period of 416 days of examination delay under 37 CFR 1.702(a)(1). Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*¹ and of the *United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term*

¹ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after national stage commence, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date that national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, January 2, 2005, and ending on the date that the patent issued, February 10, 2009.

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), the application was pending 14 months and 416 days prior to the issuance of the restriction requirement on November 21, 2007. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), the application was pending three years and 405 days prior to the issuance of the patent on February 10, 2009.

The 405 days of delay in issuance of the patent under 37 CFR 1.702(b) overlap with the 416 days of patent term adjustment under 37 CFR 1.702(a). Entry of both the 405 days and the 416 days is neither permitted nor warranted given that 416 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, having considered the 405 days of Office delay under the three-year pendency provision in conjunction with the 416 days of examination delay, reduced 29 days for applicant delay, the Office properly entered 387 days of patent term adjustment.

In view thereof, no adjustment to the patent term will be made.

Receipt is hereby acknowledged of the required patent term adjustment application fee of \$200.00.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.

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